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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/491,527 01/26/00 BASS

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EXAMINER

ALLEN, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

3
04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/491,527

Applicant(s)

BASS, JAY K.

Examiner

Marianne Allen

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Applicant is advised that they were mailed a Notice to Comply with the Sequence Rules on 4/5/00 to which they never replied. However, it is noted that while Figure 3 does disclose nucleotide sequences, these sequences are not of a length requiring compliance. Less than 10 contiguous nucleotides are disclosed.

Information Disclosure Statement

Applicant has not submitted an IDS for this application. They are encouraged to do so.

Request for Information Under 37 C.F.R. 1.105

The examiner hereby requires that applicant submit the following information as set forth under 37 C.F.R. 1.105:

Identification of any use of the claimed invention known to the inventor at the time the application was filed notwithstanding the date of the use.

A copy of any non-patent literature or published application, or patent (U.S. or foreign) that relates to quality control or quality assurance in the production or manufacture of arrays by means of depositing multiple reagent droplets generally (given the breadth of the claims) and quality control or quality assurance in the production or manufacture of oligonucleotide microarrays in particular (as they are clearly the preferred embodiment). This includes, but is not limited to, any submissions to the FDA with respect to oligonucleotide microarrays for diagnostic purposes.

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Identification of any prior art search performed by the inventor or his representatives with respect to this invention and what was searched. This includes, but is not limited to, any commercial databases or websites (URLs) known by the inventor or his representatives that could have been or were searched for information that relates to quality control or quality assurance in the production or manufacture of arrays by means of depositing multiple reagent droplets generally (given the breadth of the claims) and quality control or quality assurance in the production or manufacture of oligonucleotide microarrays in particular (as they are clearly the preferred embodiment)

This information is reasonably necessary to properly examine to treat the claimed subject matter.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to a method of generating an overlay composite, classified in at least class 707, subclass 102, for example.
- II. Claims 4-12, drawn to a first method of fabricating an array of features, classified in at least class 435, subclass 6, for example.
- III. Claim 13-15, drawn to a second method of fabricating an array of features, classified in at least class 435, subclass 6, for example.
- IV. Claims 16-17, drawn to a method of interrogating a microarray, classified in at least class 702, subclass 20, for example.
- V. Claim 18, drawn to a method of transmitting data, classified in at least class 395, subclass 559, for example.

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- VI. Claims 19-27, drawn to an apparatus for fabricating an array of features, classified in at least class 364, subclass 130, for example.
- VII. Claim 29, drawn to a first computer program product, classified in at least class 702, subclass 19, and class 382, subclass 129, for example.
- VIII. Claims 30-34, drawn to a second computer program product, classified in at least class 702, subclass 19, and class 382, subclass 129, for example.

Applicant is advised that claim 1 is directed to an unspecified method. That is, the intended goal is not recited ("A method comprising..."). As such, the final step of generating an overlay composite has been construed as being the goal of the method.

Claim 16 is dependent upon the unspecified method of claim 1 where the method additionally comprises interrogating the array. This additional step does not concern generating an overlay composite and as such, interrogating the array has been construed as being the goal of the method. Claim 17 as written appears to be dependent upon claim 15; however, it appears that this is an error and that the claim should depend upon claim 16.

Applicant is advised that claim 18 is directed to an unspecified method. That is, the intended goal is not recited ("A method comprising..."). As such, the single step disclosed of transmitting data has been construed as being the goal of the method.

Applicant is advised that claim 4 is directed to a method of fabricating an array of features; however, only the first step is directed to this goal. The second and third steps are not involved in fabricating an array of features. See also dependent claims.

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Applicant is advised that claim 13 is directed to a method of fabricating an array of features having different steps from the method of claim 4; however, only the first step is directed to this goal. The second and third steps are not involved in fabricating an array of features. See also dependent claims.

Applicant is requested to clarify the intent of their claims.

The inventions are distinct, each from the other because of the following reasons:

Each of the methods can be shown to be distinct as they each have different starting materials, method steps, and/or as set forth above, different goals. The methods would require non-coextensive searches. The apparatus and computer program products can be shown to be distinct, each from the other and from each of the methods, in that they can be used in multiple methods and each has different required elements. Each of the apparatus and computer program products would require non-coextensive searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

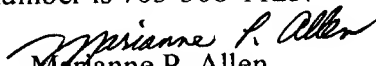
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 9:00 am - 3:00 pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3014 for regular communications and 703-308-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.


Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa
April 9, 2001


MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600